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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,816	07/22/2003	Leon M. Silverstone	BIOSCI.001C1	6648
20995	7590	04/29/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			GREENE, DANA D	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3762	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/624,816

Applicant(s)

SILVERSTONE, LEON M.

Examiner

Dana D. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-19, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16, 20, 21 and 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-19, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-22-03 &amp; 4-11-05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 14, and 17-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Diethelm (US 4,913,148, hereinafter "Diethelm"). Diethelm is considered to disclose:

a method of treating viral infections comprising applying electrical stimulation to the skin or mucosa of a patient, wherein said electrical stimulation is applied via first and second electrodes located on a surface as a series of electrical pulses (see col. 3, ln. 45-55 and col. 4, ln. 30-45, Diethelm). The disclosed application of electrical stimulation by electrodes as monopolar pulses is considered to teach the claimed method of electrical stimulation application because both treat viral infections using a series of pulses of electrical stimulation to a patient's skin;

wherein the first electrode defines a closed contour configuration that surrounds a portion of the surface and the second electrode defines another closed contour configuration that surrounds the closed contour of the first electrode (see col. 3, ln. 55 – col. 4, ln. 5, Diethelm). The disclosed circular contact surfaces of the electrodes are considered to anticipate the claimed contour configuration because both sets of electrodes are placed in contact with the patient's skin for delivery of electrical energy;

and wherein different pulses in said series have different maximum amplitudes (see col. 4, ln. 35-45, Diethelm). The disclosed pulse range and frequency range is considered to anticipate the claimed pulse differences because both methods are adapted for pulses that different in amplitude or frequency and that alternate between AC and DC pulses.

Referring to claims 9-12, Diethelm is considered to teach an adjustable current intensity that corresponds with respective skin resistance (see abstract, Diethelm). According to Diethelm, during treatment current intensity (mA) should be adjusted such that the patient feels a discernible, but not painful, throbbing (pulsation) at the surface of the skin. It will often be necessary to increase current intensity after approximately five minutes so as to counteract habituation and reach initial conditions (see col. 2, ln. 31-36, Diethelm).

With reference to claims 17-19, Diethelm is considered to disclose first and second closed contours comprising concentric circular, rectangular, and square contours (see col. 3, ln. 63 – col. 4, ln. 5, Diethelm).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Diethelm in view of Lathrop (US 5,133,352, hereinafter "Lathrop"). Diethelm is considered to disclose the claimed invention as discussed above, under the anticipatory rejection, except for the claimed housing configuration. Diethelm is considered to disclose the counter and LCD display (see col. 7, ln. 1-10, Diethelm). The disclosed display unit and measuring unit are considered to anticipate the claimed counter and display because both show the number of treatments applied.

However, Lathrop is considered to disclose the claimed housing and electrical signal source (see col. 6, ln. 55-65, Lathrop). It would have been obvious to one of ordinary skill in the art to combine the teachings of Diethelm with the considered housing configuration teaching found in Lathrop for the purpose of fitting the electrical stimulation device comfortably in the hand of the user.

### ***Double Patenting***

Claims 1 and 7 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of Silverstone (US 6,618,625, hereinafter "Silverstone") since the claims, if allowed, would

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improperly extend the "right to exclude" already granted in the patent. Although the conflicting claims are not identical, they are not patentably distinct from each other. It would have been obvious to one of ordinary skill in the art to treat the viral infection with electrical stimulation regardless of the hemispherical surface because the electrodes have a sufficient contour configuration. For example, the contour configuration works on surfaces with the hemispherical shape.

Claims 22-23 also stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 5 of U.S. Patent No. 6,618,625. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The patent clearly discloses the device for applying electrical stimulation comprising the housing, electrical circuit, and counter (see col. 16, ln. 20-40, Silverstone).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

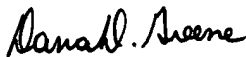
### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana D. Greene whose telephone number is (571) 273-7138. The examiner can normally be reached on M-F 9-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-0276.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dana D. Greene

  
George Manuel  
Primary Examiner